UNITED STATES PATENT AND TRADEMARK OFFICE

H·12

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,994	09/12/2003	Scott Gray	06030.00003	6077

22908   7590   09/20/2006

BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606

EXAMINER
LONG, ANDREA NATAE

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/660,994	GRAY ET AL.
	Examiner	Art Unit	
	Andrea N. Long	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1.   The information disclosure statement filed March 22, 2005 fails to comply with 37

CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications,

applications, or other information submitted for consideration by the Office; (2) U.S.

patents and U.S. patent application publications listed in a section separately from

citations of other documents; (3) the application number of the application in which the

information disclosure statement is being submitted on each page of the list; (4) a

column that provides a blank space next to each document to be considered, for the

examiner's initials; and (5) a heading that clearly indicates that the list is an information

disclosure statement. The information disclosure statement has been placed in the

application file, but there is not a list of prior art submitted for consideration. Examiner

requests the applicant to submit a list of all patent, publications, applications or other

information for consideration in this application.

Specification

2.   The disclosure is objected to because of the following informalities: Applicant

discloses an application entitled Capturing and Processing User Actions on a Computer

System for Recording and Playback. The applicant fails to provide the application/serial

number corresponding to the disclosed application. The disclosed application is not

being considered in the current application due to the missing application/serial number.

Examiner is requesting for the missing information to be submitted for consideration.

        Appropriate correction is required.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-8, 12-16, 18-27, 31 and 32 are rejected under 35 U.S.C. 102(e) as

being anticipated by Alcorn et al (U.S. Patent No. 6,988,138 B1).

As to claim 1, Alcorn discloses one or more computer-readable media containing

computer-executable instructions for facilitating distance learning (column 3 lines 57-61,

column 7 lines 25-28) by performing the steps of dynamically constructing a toolbar's

menu structure based on profile information retrieved from at least one menu profile

server computer, wherein the menu structure includes at least one menu item that,

when activated, launches at least one embedded application that is hosted on at least

one remote server computer (Fig. 1, Fig. 5, column 10 lines 15-23); and displaying a

client portion of the at least one embedded application within an embedded-application

pane on a display of a user's computer (Fig. 5).

As to claim 14, Alcorn teaches a user interface for a distance-learning system

(column 3 lines 57-61), the user interface comprising a Web-browser display (Fig.1

reference character 120), a Web-page pane within the Web-browser display that

displays a Web page (Fig. 4 reference character 404, Fig.7 reference character 700,

column 13 lines 62-64), a docked toolbar within the Web browser display (Fig. 4

reference character 403, column 9 lines 26-28), wherein the toolbar is populated with

menu items based on profile information received from a remote server computer (Fig.

1, Fig. 5, column 10 lines 15-23), and an embedded-application pane that displays,

within the Web-browser display, at least one application, which is activated from the

docked toolbar (Fig. 6 and Fig. 7).

As to claim 20, Alcorn teaches providing a distance-learning system (column 3

lines 57-61, column 7 lines 25-28), the method comprising dynamically constructing a

toolbar's menu structure based on profile information retrieved from at least one menu

profile server computer, wherein the menu structure includes at least one menu item

that, when activated, launches at least one embedded application that is hosted on at

least one remote server computer (Fig. 1, Fig. 5, column 10 lines 15-23); and displaying

a client portion of the at least one embedded application within an embedded-

application pane on a display of a user's computer (Fig. 5).

As to claim 2, Alcorn teaches wherein the profile information is specific to at least

one of an institution and an individual (column 11 lines 13-19).

As to claim 3, Alcorn teaches wherein the profile information specifies at least

one URL identifying the at last one remote server computer (column 7 line 67 through

column 8 line 5).

As to claim 4, Alcorn teaches wherein at least one remote server is at least one of a Web server (column 7 line 45).

As to claim 5, Alcorn teaches wherein the at least one menu item is selected from the group consisting of an instance of a docked info bar (Fig. 4 reference character 401 "console navbar", Fig. 5, Fig. 6).

As to claim 6, Alcorn teaches wherein the toolbar (Fig. 4 reference character 403) and the embedded-application pane (Fig. 4 reference character 404) are displayed within a Web browser's display (Fig. 5).

As to claim 7, Alcorn teaches wherein the toolbar is displayed docked within the Web browser's display (Fig. 4 reference character 403, column 9 lines 26-28).

As to claim 8, Alcorn teaches wherein the at least one menu item is selected from the group consisting of a hyperlink that, when activated, navigates a Web-page pane of the Web browser's display (column 4 lines 60-63).

As to claim 12, Alcorn teaches wherein the toolbar and the embedded-application pane are displayed within a user's desktop (Fig. 6).

As to claim 13, Alcorn teaches wherein the toolbar and the embedded-application pane are displayed within a display area of a Windows application running on the user's computer (Fig. 6).

As to claim 15, Alcorn teaches wherein the profile information is specific to at least one of an institution and an individual (column 11 lines 13-19).

As to claim 16, Alcorn teaches wherein the menu items are selected from the group consisting of a hyperlink that, when activated, navigates a Web-page pane of the Web browser's display (column 4 lines 60-63).

As to claim 18, Alcorn teaches wherein the profile information specifies at least one URL identifying at least one remote server computer that hosts the at least one application (column 7 line 67 through column 8 line 5).

As to claim 19, Alcorn teaches wherein the at least one remote server is at least one a of Web server (column 7 line 45).

As to claim 21, Alcorn teaches wherein the profile information specifies at least one of an institution and an individual (column 11 lines 13-19).

As to claim 22, Alcorn teaches wherein the profile information specifies at least one URL identifying the at least one remote server computer (column 7 line 67 through column 8 line 5).

As to claim 23, Alcorn teaches wherein the at least one remote server is at least one of a Web server (column 7 line 45).

As to claim 24, Alcorn teaches wherein the at least one menu item is selected from the group consisting of an instance of a docked info bar (Fig. 4 reference character 401 "console navbar", Fig. 5, Fig. 6).

As to claim 25, Alcorn teaches wherein the toolbar and the embedded-application pane are displayed within a Web browser's display (Fig. 4 reference character 403, reference character 404, Fig. 5).

As to claim 26, Alcorn teaches wherein the toolbar is displayed docked within the Web browser's display area (Fig. 4 reference character 403, column 9 lines 26-28).

As to claim 27, Alcorn teaches wherein the at least one menu item is selected from the group consisting of a hyperlink that, when activated, navigates a Web-page pane of the Web browser's display (column 4 lines 60-63).

As to claim 31, Alcorn teaches wherein the toolbar and the embedded-application pane are displayed within a user's desktop (Fig. 6).

As to claim 32, Alcorn teaches wherein the toolbar and the embedded-application pane are displayed within a display area of a Windows application running on the user's computer (Fig. 6).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 9-11, 17, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcorn et al (U.S. Patent No 6,988,138 B1 in view of Netter (PG Pub No. US 2002/0038388 A1).

As to claim 9, note the discussion above, Alcorn teaches the method of claim 6. Alcorn does not teach wherein a user's interaction with Web content within a Web-page pane of the browser's display causes playback by an event engine of pre-recorded interaction with at least one application displayed in the embedded application pane.

Netter teaches a user's interaction with Web content within a Web-page pane of the

browser's display causes playback by an event engine of pre-recorded interaction with

at least one application displayed in the embedded application pane (paragraph [0015],

[0017], [0020]). It would have been obvious to one skilled in the art at the time the

invention was made to have combined the browser's display of Alcorn with the record

and playback method of Netter. Netter discusses the motivation for combining by

stating that drawbacks of managing multimedia data over a network is user control and

flexibility and that existing techniques do not allow for a user to separately control

information (paragraph [0014]).

As to claim 10, note the discussion above, Alcorn teaches a toolbar. Alcorn does

not teach wherein the at least one embedded application is an ActiveX COM object

embedded within the toolbar. Netter teaches embedded applications as an ActiveX

object (paragraph [0020]). The applicant discusses how programs such as Internet

Explorer use ActiveX. Alcorn teaches how his learning system supports Internet

Explorer. It would have been obvious to one skilled in the art at the time the invention

was made to have combined the toolbar of Alcorn with the ActiveX teachings of Netter.

The motivation for combing is the same as discussed in claim 9.

As to claim 11, note the discussion above, Alcorn teaches a toolbar. Alcorn does

not teach an ActiveX COM object embedded within a browser displayed by the user's

computer. Netter teaches an ActiveX COM object embedded within a browser

displayed by the user's computer (paragraph [0020]). It would have been obvious to

one skilled in the art at the time the invention was made to have combined the toolbar of

Alcorn with the ActiveX teachings of Netter. The motivation for combing is the same as discussed in claim 9.

As to claim 17, note the discussion above, Alcorn does not teach wherein a user's interaction with Web content within a Web-page pane of the browser's display causes playback by an event engine of pre-recorded interaction with at least one application displayed in the embedded application pane. Netter teaches a user's interaction with Web content within a Web-page pane of the browser's display causes playback by an event engine of pre-recorded interaction with at least one application displayed in the embedded application pane (paragraph [0015], [0017], [0020]). It would have been obvious to one skilled in the art at the time the invention was made to have combined the browser's display of Alcorn with the record and playback method of Netter. Netter discusses the motivation for combining by stating that drawbacks of managing multimedia data over a network is user control and flexibility and that existing techniques do not allow for a user to separately control information (paragraph [0014]).

As to claim 28, note the discussion above, Alcorn does not teach wherein a user's interaction with Web content within a Web-page pane of the browser's display causes playback by an event engine of pre-recorded interaction with at least one application displayed in the embedded application pane. Netter teaches a user's interaction with Web content within a Web-page pane of the browser's display causes playback by an event engine of pre-recorded interaction with at least one application displayed in the embedded application pane (paragraph [0015], [0017], [0020]). It would have been obvious to one skilled in the art at the time the invention was made to

have combined the browser's display of Alcorn with the record and playback method of

Netter. The motivation for combing is the same as discussed in claim 9.

As to claim 29, Alcorn teaches a toolbar. Alcorn does not teach wherein the at

least one embedded application is an ActiveX COM object embedded within the toolbar.

Netter teaches embedded applications as an ActiveX object (paragraph [0020]). The

applicant discusses how programs such as Internet Explorer use ActiveX. Alcorn

teaches how his learning system supports Internet Explorer. It would have been

obvious to one skilled in the art at the time the invention was made to have combined

the toolbar of Alcorn with the ActiveX teachings of Netter. The motivation for combing is

the same as discussed in claim 9.

As to claim 30, Alcorn teaches a toolbar. Alcorn does not teach an ActiveX COM

object embedded within a browser displayed by the user's computer. Netter teaches an

ActiveX COM object embedded within a browser displayed by the user's computer

(paragraph [0020]). It would have been obvious to one skilled in the art at the time the

invention was made to have combined the toolbar of Alcorn with the ActiveX teachings

of Netter. The motivation for combing is the same as discussed in claim 9.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Cook et al. (U.S. Patent No. 6,201,948 B1) teaches an interactive

and individualized computer assisted instruction. Kilmer et al. (U.S. Patent No.

5,874,954) teaches a remote process to create, access, and process objects in a

distributed manner. Eisendrath et al. (U.S. Patent No. 6,347,333 B2) teaches a virtual

campus with interactive work plans and administrative resources presented online

through a Web interface.

Inquiries

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Andrea N. Long whose telephone number is 571-270-

1055. The examiner can normally be reached on Mon - Thurs 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chanh Nguyen can be reached on 571-272-7772. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrea N. Long
09/06/2006

CHANH D. NGUYEN
SUPERVISORY PATENT EXAMINER